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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,541	05/31/2001	Toshihiro Ogawa	209236US0	6768

22850 7590 01/09/2003

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EXAMINER

RAJGURU, UMAKANT K

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 01/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

MW-8

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on Sep 09, 2002 (paper no 5) & Dec 03, 2002 (paper no 7)
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1 and 3-19 is/are pending in the application.
- Of the above claim(s) 14-16 is/are withdrawn from consideration.
- ☒ Claim(s) 11-13 is/are allowed.
- ☒ Claim(s) 1, 3-10 and 17-19 is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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1. An amendment (paper no. 5) has been filed on September 09, 2002.

*OK* A supplemental amendment (paper no. 7) has been filed on Dec <sup>03</sup>~~10~~, 2002.

2. Claims under examination now are 1 and 3-19.

3. Applicant's election with traverse of group I claims 1-13 in Paper No. 5 is acknowledged.

The traversal is on the ground(s) that groups II and I are drawn to a combination and a subcombination resp. This is not found persuasive because while the examiner disagrees with the applicants with their above categories, even assuming that the reasoning is valid, the subcombination can be used as a material for coating by spraying. Contrary to the applicants' argument which is only a conclusionary statement, there is serious burden for search and examination for both the cited groups.

The requirement is still deemed proper and is therefore made FINAL.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Rejection of claims 3, 4, 8, 9 and 12 under 35 USC 112, 2<sup>nd</sup> paragraph (see item 4 of prior Office action, paper no. 4) is maintained since the applicants have not amended those claims appropriately and applicants' arguments are not persuasive.

New claim 19 also stands rejected under 35 USC 112, 2<sup>nd</sup> paragraph.

*withdrawn  
06.30.03*

6. Claims 1 and 3 are rejected under U.S.C. 102(b) as being anticipated by Reinhardt et al (WO 94/04599), JP 2000-633552, JP 2000-034416, Ezoe (USP 5,523,331), Laliberte (USP 2,701,911) or JP 03266706.

This rejection is incorporated here by reference from same prior Office action paper no.

4, item 6.

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7. Applicant's arguments filed September 09, 2002 (Paper No. 5) have been fully considered but they are not persuasive.

On page 5 of above paper no. 5, the applicants argue that claims 1 and 3 are not anticipated by prior art because of the new limitation. This argument is not persuasive because prior art teaches a composition containing claimed ingredients and amounts that are same or overlapping to the claimed ones. It is reasonable therefore to infer that prior art inherently meets the (claimed) limitation unless proved otherwise.

8. Rejection of claims 1 and 3-10 under 35 USC 103(a) (item 8 of Office action) <sup>paper 4</sup> is now withdrawn.

9. Claims 1, 3-10 and ~~17-19~~ <sup>withdrawn 06-30-2003</sup> are rejected under 35 U.S.C. 103(a) as being unpatentable over Laliberte (USP 270191) in view of Yokohama (JP 03266706).

Disclosures of these reference are set forth in earlier Office action.

Laliberte fails to mention the inorganic water soluble particles (of instant claim 4).

It would have been obvious to incorporate the water soluble inorganic compounds of Yokohama into the polishing pad of Laliberte in order to enhance abrasion resistance thereby diminishing environmental pollution.

10. Claims 11-13 are allowable now.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to U.K. Rajguru whose telephone number is 703-308-3224. The examiner can normally be reached on Monday-Friday from 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 703-308-2462. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



U. K. Rajguru/mn  
December 23, 2002



James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700